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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,137

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Kamaljit S. Paul

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EXAMINER

ARAJ, MICHAEL J

ART UNIT

PAPER NUMBER

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/627,137

Applicant(s)

PAUL, KAMALJIT S.

Examiner

Michael J. Araj

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-13, 17-35 and 41-76 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 and 36-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-58 is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13, 18, 21, 25-35, 59, 61-67 and 69-76 is/are rejected.
- 7) ☒ Claim(s) 10, 19, 20, 22-24, 60 and 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date see continuation.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continued from 3) 2/2/2006, 9/6/2006,9/12/2006

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 59, 67 and 69 are rejected, as understood, under 35 U.S.C. 102(b) as being anticipated by Errico et al. (U.S. Patent No. 5,876,402).

Errico et al. disclose a spinal plate (100) having a length comprising a top and bottom surface and a plurality of circular bone-fastener-receiving apertures with a transversely resiliently movable retaining element (180) mounted to said spinal plate and extending between first and second ones of said bone-fastener-receiving apertures (110,112) and extending into at least one of said bone-fastener-receiving apertures (see Figure 6). Said retaining element comprises a resiliently movable band, a length of said band extending alongside, and extending across a portion of one corresponding aperture. Also disclosed is a retaining band mounted to said spinal plate and extending into at least one of said bone-fastener-receiving apertures and causes an automatic blocking feature of a bone fastener when driven through said aperture. The apertures

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are tapered making the top length greater than the respective lower width. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Errico et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 1, 11,12, 18 and 70-76 are rejected, as understood, under 35 U.S.C. 102(e) as being anticipated by Needham et al. (U.S. Patent No. 6,533,786).

Needham et al. disclose a spinal plate (30) having a length comprising a top and bottom surface and a plurality of slot-shaped bone-fastener-receiving apertures (32) with a resiliently movable retaining element (33) extending substantially along the full length of the plate that is mounted to said spinal plate and extending between first and second ones of said bone-fastener-receiving apertures (32) and extending into at least one of said bone-fastener-receiving apertures. Said retaining element comprises a resiliently movable band, a length of said band extending alongside, and extending across a portion of one corresponding aperture. Needham et al. also disclose an intermittent channel (39) extending along the length of the spinal plate and intermittently

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expressed adjacent the apertures where a retaining band is mounted and is used in consequence to activate a blocking feature of said spinal plate assembly. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Needham et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8, 13,20, 21,25-35, 61-66 are rejected, as understood, under 35 U.S.C. 103(a) as being unpatentable over Needham et al. (U.S. Patent No. 6,533,786).

Needham et al. disclose the claimed invention except for the device being made of different materials such as implantable plastics and metals and having a second

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movable band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create this spinal plate assembly with the disclosed materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard to claim 20, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Needham having a second band, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Allowable Subject Matter

Claims 41-58 are allowed.

Claims 10, 19, 20, 22-24, 60 and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed August 28, 2006 have been fully considered but they are not fully persuasive.

In response to the election/restriction, it remains final as stated in the non-final action mailed December 15, 2005. Claims 14-17 and 36-40 have been withdrawn from consideration. Applicant is reminded that upon the allowance of a generic claim,

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applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. Also, applicant did not understand why claims 36-39 stand withdrawn. From the response to the election/restriction (mailed August 19, 2005) received on September 21, 2005 it specifically states that only claims 1-15, 18-35 and 40-67 read on the elected species.

In response to Errico et al., with respect to claim 59, not teaching any blocking structure on the bone fastener and the applicant teaches a less complex solution to the matter of screw retention is not persuasive. Errico et al. still reads on the claimed limitations as well as the head of the fastener can be considered a blocking feature.

In response to Needham et al., with respect to claim 1, not having a resiliently transversely movable retaining element, it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). As stated in the response, one can take the position that all materials have a "resilient" element so long as the Young's modulus is not exceeded. The retaining element will be deformed transversely as a fastener passes the retaining element. Once the fastener fully passes the retaining element, the retaining element will move towards but not "to" the first position because of the material properties.

With respect to new claims 70-75, they read on the prior art as disclosed above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Araj whose telephone number is 571-272-5963. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MJA


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SUPERVISORY PATENT EXAMINER